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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-----------------------------|
| 09/866,598 | 05/30/2001 | Domenic Cosentino | COSE3001/JEK | 4955 |
| 23364 | 7590 | 10/36/2003 | EXAMINER | |
| BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314 | | | | TORRES VELAZQUEZ, NORCA LIZ |
| | | ART UNIT | | PAPER NUMBER |
| | | 1771 | | |

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/866,598 | COSENTINO, DOMENIC | |
| | Examiner | Art Unit | |
| | Norca L. Torres-Velazquez | 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

a. The rejection of claims 6 and 10 under 35 U.S.C. 112, second paragraph, have been withdrawn in view of Applicant's amendment of the Specification in which the "composite weave" is described as being a fabric formed of woven strands each of which is of a composition comprising a mixture of two or more plastic materials.

b. Applicants have included the limitation "decorative, non-utilitarian" in the claims, abstract and the specification to distinguish their invention from the invention of Eckenroth. Applicants indicate that support for this limitation if found in paragraphs 0001, 0002, 0016 and 0017 of the written description.

It is the Examiner position that while the specification describes the aesthetic property of the trim member in its applications it does not describe its "non-utilitarian" characteristic. The added limitations are considered new matter as stated below. Therefore, the Examiner maintains her position of interpreting the dashboard mountings in Eckenroth as the insert panels of the present invention.

c. The rejection of claims 1, 4 and 7 under 35 U.S.C. 102(b) over ERWIN have been withdrawn in view of Applicant's remarks indicating that the reference fails to disclose the opening in a main plate.

d. A new rejection has been included in the present Office Action over STAPAZZINI (US 5,529,742).

Specification

2. The amendment filed on July 16, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the inclusion of the limitation "non-utilitarian".

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have included the limitation "decorative, non-utilitarian" in the claims, abstract and the specification to distinguish their invention from the invention of Eckeneroth. Applicants indicate that support for this limitation if found in paragraphs 0001, 0002, 0016 and 0017 of the written description. It is the Examiner position that while the specification describes the aesthetic property of the trim member in its applications it does not describe its "non-utilitarian" characteristic.

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5. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "non-utilitarian" is new matter, because this negative limitation is not literally supported by the original specification. *Ex Parte Grasselli*, 231 USPQ 393.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by STRAPAZZINI (US 5,529,742).

STRAPAZZINI discloses plastic panels which are useful as automotive trim panels, interior door panels and the like decorative and structural panels, and are made by a method which integrates insert sections in the surfaces of the panels and eliminates insert edge trim molding strips. The composite sheet and insert forms an exposed, decorative surface on the molded plastic panel. (Abstract) The reference further discloses that a major object of their invention is to provide a method which produces panels that have inserts of different textures or types of materials for decorative enhancement, but wherein the normal edge trim molding which has been required in the past to conceal and protect the edges of the inserts may be completely eliminated. (Column 2, lines 23-28) The reference teaches that the molding process involves

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starting with a sheet 18, which is cut or formed into a desired size to provide a blank for molding purposes. The sheet may have a face, which is pre-embossed or pre-textured. Then the inserts are bonded to the blank, once the insert is bonded to the blank, sheet portions 22 of the blank which overlap the insert and the selvage portions 23 of the insert are torn away. The removal of the portion of the sheet, which overlaps the insert permits the insert to be arranged substantially coplanar with the sheet and exposed the insert face within a window-like opening in the sheet as illustrated in Figure 8. That leaves the welded joint 21 surrounding the insert. (Refer to Column 3, lines 25-67 through Column 4, lines 1-21) The reference further teaches that the inserts may be in the form of smaller sections or panels, which may be formed, for example, of carpet-like sheets or sheets with heavily textured surfaces or sheets of different surface colors or materials. (Column 1, lines 28-31) The reference also discloses the use of panel inserts which may have an interior face formed so as to simulate a wood grain appearance. Similarly, the insert may be formed of a pile, carpet-like material, to simulate a carpeted section of the panel. (Column 3, lines 30-35) The reference further teaches that the panel may be provided with various openings or receptacle areas, after the molding is completed, to receive some of the hardware, which is typically mounted within a vehicle door. (Column 3, lines 36-40)

It is the Examiner's interpretation that the molding process described by STRAPAZZINI produces the present overlay trim member. It produces a trim member with a blank sheet that would equate to the claimed main plate, in the process there is a window-like opening in the sheet that provides the space for the insert face that equates to the claimed decorative insert plate. The blank sheet and the insert face are of different materials. Then the molded panel is mounted to a backing member such as a vehicle door.

With regards to claimed material for the inner plate and main plate, it is noted that the reference teaches the use of materials simulating a wood grain appearance, materials formed of a pile and carpet-like materials, which are known to comprise carbon fibers, films and the claimed “composite weave”. Therefore, it is the Examiner position that the disclosure of STRAPAZZINI is broad enough to anticipate these limitations.

With regard to the claimed polyester, urethane or epoxy coating in the plates, it is noted that the reference discloses that the overall molded plastic panel is waterproof and that conventional water shields that typically are utilized within vehicle doors, for protecting the trim panel from water seepage are unnecessary and eliminated reducing the cost of the overall door assembly considerably. (Column 6, lines 1-6) It is noted that the waterproof ness of the panel of the STRAPAZZINI is a result of the method used to make the panel and that is the reason for not using the conventional coatings, however, it is known in the art to use these coatings. Therefore, it is the Examiner's position that the use of polyester, urethane or epoxy coatings is anticipated by the reference as it discloses the general state of the art and because the particular coatings claimed in the present invention are known for their waterproof ness properties.

8. Claims 1-4, 7-8 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by ECKENROTH (US 3,423,276) as stated in previous action.

ECKENROTH discloses a decorative covering for dashboard panels and the like formed of a thin sheet of decorative wood paneling material backed by a thin, porous reinforcing sheet, with the back of the latter bearing a pressure-sensitive adhesive to adhere the sheets to a panel. (Abstract) The reference teaches the use of wood material, vinyl imitation wood, metal-flaked plastic sheet as decorative paneling material. (Column 1, lines 32-35 and Column 2, lines 1-5).

ECKENROTH further teaches that if the covering 10 is to cover a dashboard, access holes are cut through the decorative and reinforcing sheets to allow the covering to closely fit around instrument mountings on the dashboard panel. (Column 2, lines 30-34) The reference further teaches the use of a protective finish over the outer surface of the decorative sheet. (Column 2, lines 7-13).

It is noted that the Examiner interprets the claimed insert plate(s) as the instrument mountings of the ECKENROTH reference. (Refer to Figures 1-4)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over ECKENROTH (US 3,423,276) as applied to claims 1-4, 7-8 and 11-15 above, and further in view of MAEDA et al. (US 5,247,018) as stated in previous action.

However, the reference does not disclose the use of carbon fibers.

MAEDA et al. discloses a thermoplastic resin or elastomer composition that is valuable as a material for an interior automotive trim. The reference teaches that if a layer of this thermoplastic elastomer composition is laminated with a polyurethane layer, a laminate having excellent tensile strength and heat resistance is obtained. (Abstract) The reference further teaches the use of fibrous filler such as a carbon fiber. (Column 6, lines 58-66).

Since both ECKENROTH and MAEDA et al. are from the same field of endeavor, the purpose disclosed by MAEDA et al. would have been recognized in the pertinent art of ECKENROTH.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the trim member and provide it with carbon fiber with the motivation of imparting dimension stability and shape stability to the composition of the plate(s) as disclosed by MAEDA et al. (Column 4, lines 15-17)

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 703-306-5714. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm..

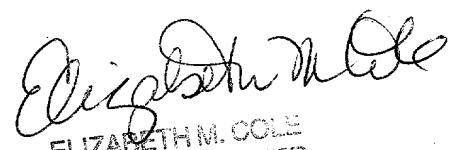
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

NLT

October 9, 2003



ELIZABETH M. COLE
PRIMARY EXAMINER